

ESTTA Tracking number: **ESTTA486036**

Filing date: **07/27/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054069
Party	Plaintiff Marc Hogue
Correspondence Address	JIMMIE PURSELL JENNINGS STROUSS & SALMON PLC 1 E WASHINGTON ST STE 1900 PHOENIX, AZ 85004-2554 UNITED STATES jpursell@jsslaw.com
Submission	Other Motions/Papers
Filer's Name	Jimmie Pursell
Filer's e-mail	trademarks@jsslaw.com
Signature	/Jimmie Pursell/
Date	07/27/2012
Attachments	Amended Petition for Cancellation No. 92054069.pdf (6 pages)(2410055 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MARC HOGUE, Petitioner, SKYDIVE ARIZONA, INC., Respondent.	Cancellation No. 92054069 Reg. No. 3,099,847
---	---

AMENDED PETITION FOR CANCELLATION OF REGISTRATION

Petitioner Marc Hogue, an individual residing in Phoenix, Arizona, is being damaged by the registration of the trademark SKYDIVE ARIZONA (stylized) to Skydive Arizona, Inc. (“Respondent”), depicted in Registration No. 3,099,847, and hereby petitions to cancel the same.

The grounds for cancellation are:

1. Marc Hogue (“Petitioner” or “Hogue”) provides skydiving educational services, including instructions and training in parachuting and skydiving, within the State of Arizona, through business entities in which he is a member or shareholder, including Skydive Force, Inc., Skydive Coolidge, Inc., and Skydive Phoenix, Inc..

2. Respondent is an Arizona corporation having its principal place of business in Eloy, Arizona. On or about June 17, 2005, Respondent filed an application for federal registration of the mark SKYDIVE ARIZONA (the “Application”). The Application was filed under § 1(a) and 2(f) of the Trademark Act, 15 U.S.C. § 1051(a) and 15 U.S.C. § 1052(f), and was assigned serial number 76/641,146.

3. In the Application, Respondent claimed actual use of the mark in connection with “[e]ducational services, mainly, providing instructions and training of parachuting and skydiving,” in International Class 41.

4. Upon information and belief, Respondent offers skydiving instruction services only within the State of Arizona.

5. On or about January 12, 2006, the United States Patent and Trademark Office issued a non-final office action denying registration to Respondent because the word “SKYDIVE” was “merely descriptive because it describes a feature of the applicant’s educational services.”

6. By Examiner’s Amendment dated January 20, 2006, the Application was amended to include the disclaimer “no claim is made to the exclusive right to use skydive apart from the mark as shown.”

7. The Application passed to publication and was subsequently registered on June 6, 2006.

FIRST CLAIM FOR RELIEF

CANCELLATION FOR DESCRIPTIVENESS

8. Petitioner incorporates in this first claim for relief all of the prior paragraphs in this Amended Petition for Cancellation.

9. The mark SKYDIVE ARIZONA is descriptive because the mark as a whole describes Respondent’s services, *i.e.*, skydiving instruction within the State of Arizona.

10. The United States Patent and Trademark Office has already required Respondent to disclaim exclusive use of the word “SKYDIVE” because that term is descriptive of a feature of Respondent’s services.

11. Respondent’s registration prevents others who provide educational and instructional skydiving services in Arizona from describing their services being offered without facing a challenge from Respondent.

12. Petitioner is harmed by the registration of Respondent’s mark because Petitioner is unable to offer his goods and services, *i.e.*, skydiving instruction in Arizona, without facing a challenge from Respondent for alleged infringement of Respondent’s mark.

13. For the foregoing reasons, Petitioner is entitled to an order cancelling the Registration of Respondent’s mark.

SECOND CLAIM FOR RELIEF

CANCELLATION FOR MARK CONSISTING OF GEOGRAPHICAL INDICATION

14. Petitioner incorporates in this second claim for relief all of the prior paragraphs in this Amended Petition for Cancellation.

15. Upon information and belief, Respondent offers its skydiving services exclusively within the State of Arizona.

16. The word Arizona when used in conjunction with the descriptive word skydive is merely geographically descriptive of Respondent's skydiving services.

17. Respondent's mark is unregistrable pursuant to § 2(e) of The Trademark Act, 15 U.S.C. § 1052(e).

18. Petitioner is harmed by the registration of Respondent's mark because Petitioner also provides skydiving education and instruction within the State of Arizona and cannot describe his services without risking infringing Respondent's mark.

19. For the foregoing reasons, Petitioner is entitled to an Order cancelling the registration of Respondent's mark.

THIRD CLAIM FOR RELIEF

RESPONDENT'S MARK HAS NOT ACQUIRED DISTINCTIVENESS UNDER SECTION 2(f)

20. Petitioner incorporates in this third claim for relief all of the prior paragraphs in this Amended Petition for Cancellation.

21. Respondent's mark has not acquired distinctiveness under Section 2(f) for the identified services.

22. Considering the descriptive (generic) and geographically descriptive nature of Respondent's mark, Respondent's evidence of acquired secondary meaning is insufficient to establish that Respondent's mark acquired secondary meaning as a trademark, and the United

States Patent and Trademark Office erred in accepting that evidence as proof of acquired secondary meaning.

23. Upon information and belief, Petitioner and others have used the words “skydive Arizona,” “skydive in Arizona,” “skydiving in Arizona,” and other variations thereof prior to and following Respondent’s Application. This widespread use by others to describe skydive related services within Arizona indicates that Respondent’s use of “skydive Arizona” has not been exclusive. This widespread use by others also indicates that consumers do not associate services connected with the words “skydive Arizona” as emanating from a single source. Furthermore, consumers know Respondent’s business by, and associate the business with, its local geographical location, *i.e.*, “Eloy” or “the drop zone at Eloy.” Therefore, Respondent’s use of the SKYDIVE ARIZONA mark has not been the type of use that could acquire secondary meaning, and Respondent’s evidence of acquired distinctiveness is insufficient to support registration of the SKYDIVE ARIZONA mark pursuant to Section 2(f).

24. Respondent’s registration prevents Petitioner and others who provide educational and instructional skydiving services in Arizona from describing their services without facing a challenge from Respondent.

25. For the foregoing reasons, Petitioner is entitled to an order cancelling the Registration of Respondent’s mark.

//

//

//

//

//

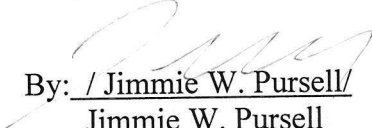
//

//

WHEREFORE, Petitioner respectfully requests an order granting this Petition of Cancellation and cancelling Registration No. 3,099,847.

July 27, 2012

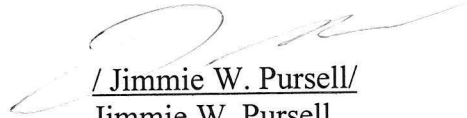
Respectfully submitted,

By:  / Jimmie W. Pursell/

Jimmie W. Pursell
Jennings Strouss & Salmon PLC
One East Washington St.
Suite 1900
Phoenix, AZ 85004
(602) 262-5812
Fax (602) 495-2643
Trademarkss@jsslaw.com

Certificate of Service

The undersigned certifies that a copy of this Petition for Cancellation was sent by certified first class mail to: Sid Leach, Esq., SNELL & WILMER, One Arizona Center, 400 E. Van Buren Street, Suite 1900, Phoenix, AZ 85004 and to: SKYDIVE ARIZONA 4900 N. Taylor Road, Eloy, AZ 85231, this 27th day of July, 2012.


/ Jimmie W. Pursell/
Jimmie W. Pursell